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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,257	01/21/2004	Kia Silverbrook	WAL09US	1584

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SILVERBROOK RESEARCH PTY LTD
393 DARLING STREET
BALMAIN, 2041
AUSTRALIA

EXAMINER	
UHLENHAKE, JASON S	

ART UNIT	PAPER NUMBER
2853	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/760,257	SILVERBROOK ET AL.	
	Examiner	Art Unit	
	JASON S. UHLENHAKE	2853	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 April 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-48* is/are pending in the application.

4a) Of the above claim(s) *14-16,18,20-30,32-36,39 and 41-47* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13,17,19,31,37,38,40 and 48* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *21 January 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *12/12/2004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Invention I, claims 1-13, 17-19, 31, 37, 38, 40, 48 in the reply filed on 4/3/2008 is acknowledged. Claim 14-16, 18, 20-30, 32-36, 39, 41-47 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Inventions II-VIII, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 4/3/2008.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 46 of U.S. Patent No. 6,944,970. Although

the conflicting claims are not identical, they are not patentably distinct from each other because it would be obvious to charge the customer for roll of printed paper.

Claims 1, 13 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 11 of U.S. Patent No. 7,108,434. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would be obvious to charge the customer for the roll of printed paper.

Claims 1-13 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-13 of copending Application No. 10/760,241. Although the conflicting claims are not identical, they are not patentably distinct from each other because each of the identified claims above anticipates the current claimed invention

Claims 1-12, 17, 19, 31, 37, 38, 40, 48 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12, 17, 19, 31, 37, 38, 40, 48 of copending Application No. 10/760,240. Although the conflicting claims are not identical, they are not patentably distinct from each other because each of the identified claims above anticipates the current claimed invention

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 13 recites the limitation "the tote" in line 3 of Claim 13. There is insufficient antecedent basis for this limitation in the claim. Appropriate correction is required

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 1, 6, 8-9, 11-12, 17, 19, 37-38, 40, 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (U.S. Pub. 2002/0171692) in view of Goldstein (U.S. Pub. 2002/0069078)

Martin discloses:

- ***regarding claims 1, 37, 40, 48,*** a method for operating a wallpaper printing business, comprising: utilizing an on-demand printer comprising a cabinet in which is located a media path which extends from a media loading area to a print head and from the print head to a dispensing slot; (Figure 2; Paragraphs 0009-0010)

- using one or more printer input devices which communicate with a processor to capture data regarding one or more customers requirements; the data comprising at least a customer selected patter; printing a roll of wallpaper, onto a web of blank media, on demand, according to the selected pattern (Figure 2; Paragraphs 0009-0010)

- ***regarding claim 6,*** providing the printer with a scanner for capturing data that specifies a selected pattern or other data (Claims 10-11: since the printer is a xerographic, the printer comprises a scanner)

- ***regarding claim 8,*** the customer selected patter is selected by the customer from a collection of swatches which correspond to patterns that the printer is able to print on demand (Figure 1; Paragraph 0009)

- ***regarding claim 9,*** the customer can use an input device to alter how the printer prints a selected pattern (Figure 1; Paragraph 0009)

- ***regarding claim 11,*** the customers requirements comprise a pattern and a configuration; the configuration being one or more parameters selected from the group comprising: roll length, a roll slitting arrangement, one or more modifications to the pattern, or a selection of media to be printed on (Paragraph 0010)

- ***regarding claim 12,*** loading a media canister into the printer, the canister containing an unprinted web of media; and using a motor in the printer to advance the unprinted web into the path; automatically threading the media form the loading area to the dispensing slot (Figure 2; Paragraphs 0009-0010)

- ***regarding claim 17,*** an operator uses the printer for a customer (Paragraph 0011)

- ***regarding claim 19,*** selling printed rolls as they are produced to eliminate printed wallpaper inventory (Figure 3; Paragraph 0011)

- ***regarding claim 38,*** providing to franchisees, an on-demand printer comprising a cabinet in which is located a media path which extends from a media

loading area to a print head and from the print head to a dispensing slot; the printer having one or more printer input device which communicate with a processor to capture data regarding one or more customer requirements, the data comprising at least a customer selected pattern; providing the franchisee with a collection of patterns in a digital storage medium that can be read by the printer; enabling the franchisee to print a roll of wallpaper onto a web of blank media on demand according to the selected pattern (Figures 1-3; Paragraphs 0009-0011)

Martin does not disclose expressly the following:

- ***regarding claim 1,*** charging a customer for the roll
- ***regarding claim 38,*** obtaining or attempting to obtain a fee from the franchisee

Goldstein discloses:

- ***regarding claim 1,*** charging a customer for the roll. Goldstein discloses a system for creating custom wallpaper including a program to charge and obtain fee from customers who ordered printed wallpaper rolls (Figure 2, steps 208, 210, 212, 214)
- ***regarding claim 38,*** obtaining or attempting to obtain a fee from the franchisee (Figure 2, steps 208, 210, 212, 214)

It would have been obvious to a person of ordinary skill in the art to incorporate the teaching of Goldstein into the device of Martin, for the purpose of allowing an operator/customer to purchase created custom wallpaper (Paragraphs 0043-0046)

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (U.S. Pub. 2002/0171692) as modified by Goldstein (U.S. Pub. 2002/0069078) as applied to claim 1 above, and further in view of Fujii et al (U.S. Pat. 6,715,423) and Kwasny (U.S. Pub. 2002/01189900)

Martin as modified by Goldstein discloses all of the claimed limitations except for the following:

- ***regarding claim 2,*** the printer allows the customer to select a width; the printer captures the width as data with a printer input device; and the printer is used to slit the web to the width

Fujii et al teaches calculating an amount of wallpaper required by the customer based on room dimensions such as width supplied by customers (Figures 6-7, 9). However, Fujii et al does not disclose cutting/slitting a web. ***Kwasny*** teaches a slitting/cutting mechanism (16) for slitting a web.

It would have been obvious to one of ordinary skill in the art to incorporate the teachings of Fujii and Kwasny into the device of Martin as modified by Goldstein, for the purpose of improving the efficiency of cutting a web into multiple narrow sheets

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (U.S. Pub. 2002/0171692) as modified by Goldstein (U.S. Pub. 2002/0069078) as applied to claim 1 above, and further in view of Stoffel et al (U.S. Pat. 6,412,990)

Martin as modified by Goldstein does not disclose expressly the following:

- ***regarding claim 5,*** acquiring data from a touch-screen display which is also adapted to display the pattern

Stoffel discloses:

- ***regarding claim 5,*** acquiring data from a touch-screen display which is also adapted to display the pattern (42 of Figure 15; Column 8, Lines 55-60)

At the time the invention was made it would have been obvious to a person of ordinary skill in the art to incorporate the teaching of Stoffel into the device of Martin as modified by Goldstein, for the purpose of allowing an operator/customer to custom print images by simply touching the viewing screen (Column 8, Lines 55-60)

Claims 3-4, 7, 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (U.S. Pub. 2002/0171692) as modified by Goldstein (U.S. Pub. 2002/0069078) as applied to claim 1 above, and further in view of Kawamura et al (U.S. Pat. 6,249,301)

Martin as modified by Goldstein discloses:

- ***regarding claim 3,*** allowing the customer to select a roll length; capturing the roll length as data with a printer input device (Martin: Paragraphs 0009-0010)
- ***regarding claim 4,*** charging the customer only for the length Goldstein discloses a system for creating custom wallpaper including a program to charge and obtain fee from customers who ordered printed wallpaper rolls (Goldstein: Figure 2, steps 208, 210, 212, 214)
- ***regarding claim 7,*** allowing the customer to select a media type and using that media type in the printer (Martin: Figures 1-2; Paragraph 0010)

- ***regarding claim 13,*** winding a printed roll of wallpaper onto a core (Martin: Figure 2; Paragraph 0009; element 26 - take-up roller)

Martin as modified by Goldstein does not disclose expressly the following:

- ***regarding claim 3,*** using the printer to cut the web to the roll length
- ***regarding claim 13,*** loading a disposable media tote into a winding area adjacent to the dispensing slot; a winding core inside the tote and severing the printed roll on the core form the web

Kawamura discloses:

- ***regarding claim 3,*** using the printer to cut (17) the web to the roll length (Figure 4; Abstract; Column 3, Lines 42-60)
- ***regarding claim 13,*** loading a disposable media tote into a winding area adjacent to the dispensing slot; winding a printed roll of wallpaper onto a core inside the tote and severing the printed roll on the core form the web (Figure 4; Abstract; Column 3, Lines 42-60)

At the time the invention was made it would have been obvious to a person of ordinary skill in the art to incorporate the teaching of Kawamura into the device of Martin as modified by Goldstein, for the purpose of providing a high-quality picture at a low running cost

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (U.S. Pub. 2002/0171692) as modified by Goldstein (U.S. Pub. 2002/0069078) as applied to claim 1 above, and further in view of Lapointe et al (U.S. Pat. 5,056,142)

Martin as modified by Goldstein discloses all of the claimed limitations except for the following:

- ***regarding claim 10,*** assigning a symbol to each swath

Lapointe discloses:

- ***regarding claim 10,*** Lapointe discloses a device that has a sample book of samples that each contain symbols (Column 1, Lines 53-60; Column 4, Lines 59-68)

At the time the invention was made it would have been obvious to a person of ordinary skill in the art to incorporate the teaching of Lapointe into the device of Martin as modified by Goldstein, for the purpose of providing a easier method of identifying a particular sample in a quick, efficient amount of time

Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (U.S. Pub. 2002/0171692) as modified by Goldstein (U.S. Pub. 2002/0069078) as applied to claim 1 above, and further in view of Kawamura et al (U.S. Pat. 6,249,301) and Zander (U.S. Pat. 5,200,777)

Martin as modified by Goldstein discloses all of the claimed limitations except for the following:

- ***regarding claim 31,*** a case in which a roll of blank media may be deployed; the case having two halves, hinged together, an area between the two halves, when closed, defining a media supply slot; and the case having internally and adjacent to the slot, a pair of rollers, at least one of the rollers being a driven roller which is supported at each end by the case for rotation by an external motor

Zander discloses:

- ***regarding claim 31,*** the case having two halves, hinged together (Figure 2), an area between the two halves, when closed, defining a media supply slot (47); (Figures 2, 8-9)

Kawamura discloses:

- ***regarding claim 31,*** a case in which a roll of blank media may be deployed; and the case having internally and adjacent to the slot, a pair of rollers (23), at least one of the rollers being a driven roller which is supported at each end by the case for rotation by an external motor (Figure 4; Column 4, Lines 1-7)

At the time the invention was made it would have been obvious to a person of ordinary skill in the art to incorporate the teaching of Zander and Kawamura into the device of Martin as modified by Goldstein, for the purpose of providing a high-quality picture at a low running cost and providing easily accessible media supply container

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASON S. UHLENHAKE whose telephone number is (571)272-5916. The examiner can normally be reached on Monday-Friday 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Meier can be reached on (571) 272-2149. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JASON S UHLENHAKE/
Examiner, Art Unit 2853
June 20, 2008

/Julian D. Huffman/
Primary Examiner, Art Unit 2853